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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85831682
Applicant	Adlon Brand GmbH & Co. KG c/o FUNDUS FONDS - Verwaltungen GmbH
Applied for Mark	ADLON
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re:	:	
Trademark Application Serial No.: 85/831,682	:	
	:	
Filed: January 24, 2013	:	
	:	
Mark: ADLON	:	Attorney Docket No. 22407-00118
	:	
	:	
Adlon Brand GmbH & Co. KG c/o FUNDUS	:	
FONDS – Verwaltungen GmbH,	:	
Applicant.	:	
	:	
	:	

APPLICANT’S REPLY BRIEF

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I. INTRODUCTION

Applicant respectfully submits the ADLON mark should be allowed registration because, at best, it is an extremely rare surname and, as Judge Seeherman points out in her concurrence in *In re Joint-Stock Company “Baik,”* if a “surname is extremely rare, it is also extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant” and refusing registration does not serve the intention of the Lanham Act. 84 USPQ2d 1921, 1924 (TTAB 2007). Additionally, there is significant evidence that the mark is distinctive and would be perceived by the consumer as a trademark and not primarily merely a surname and, specifically, as indicating Applicant itself and/or the well-known Hotel Adlon and the source of its goods/services.

II. ARGUMENT

A. The Mark Is an Extremely Rare Surname At Best And Refusing Registration Does Not Serve the Purpose of The Lanham Act

The record shows ADLON is, at best, an extremely rare surname. In “*Baik*,” the examining attorney provided a summary and partial listing of 456 individuals having “Baik” as a surname, and concluded that the name appeared to be a relatively rare surname. *Id.* at 1922. Based upon this evidence, the Board clarified the examining attorney’s conclusion and stated Baik was “an *extremely rare* surname.” *Id.* (emphasis added). In the instant case, the Examining Attorney points to listings of “Adlon” from excerpts of only two directories of names, namely 411.com and Switchboard.com, and each of these includes numerous duplicates as discussed at length in Applicant’s Brief, Section IV.A.i. Thus, although the exact number is unclear from the excerpts submitted, it appears likely the offered listings show fewer than 100 entries, and this would not support such a refusal. Out of the entire U.S. population of approximately 320 million

people, under 100 listings illustrates “ADLON” is *extremely rare* and it would not serve the purpose of the Lanham Act to refuse registration because it is extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant.

Other listings the Examining Attorney relies on include unreliable “social media and networking outlets” and “major genealogy websites” (Examining Attorney’s “EA” Brief, p. 4). As discussed further in Applicant’s Brief, Section IV.A.ii., these excerpts should not be given weight because the results are skewed, unreliable, and unverifiable, and also likely include individuals outside the United States. Accordingly, it is clear that Adlon is, at best, an extremely rare surname and thus there is no purpose behind a refusal of the registration of the mark. *See “Baik,”* 84 USPQ2d at 1924 (Seeherman concurrence).

B. The Mark Is Distinctive And Would Be Perceived As a Trademark

Often a word will have a meaning or significance in addition to its significance as a surname. The issue is to determine the primary meaning of the term to the consumer. *See* TMEP § 1211.01(a). In this case, ADLON has non-surname significance and the consumer would perceive the mark as indicating Applicant itself, Adlon Brand GmbH & Co. KG and/or the Hotel Adlon, and the source of its goods/services.

The Examining Attorney misunderstands and asserts that Applicant has not provided evidence of acquired distinctiveness under TMEP Section 1212.08 (EA Brief, p. 8-9). To clarify, Applicant is not arguing acquired distinctiveness but is explaining that the lack of current association with an individual with the surname ADLON, which has been “replaced” by a different association with a hotel, further confirms that this factor weighs in favor of registration. Applicant contends that the ADLON mark has meaning as the source of its goods/services and

would be perceived as such by the consumer, rather than as primarily merely a surname, as shown by the significant evidence adduced by Applicant and discussed in Applicant's Brief, Section IV.C.i.

C. The Case Law is Distinguishable

The case law cited by the Examining Attorney is distinguishable because the evidence of the perception of the mark at issue as a surname is significantly more – quantitatively and qualitatively. For example, the Examining Attorney's Brief cites to *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004). EA Brief, p. 7. In *Gregory*, the Board found it significant that at least two politicians had the last name ROGAN and would therefore campaign for election and be mentioned in news reports on government activities, and thus, that a large number of individuals would be exposed to this name and concluded ROGAN was not a rarely used surname. In *Gregory*, there was also evidence of a baseball player enshrined in the National Baseball Hall of Fame, an author of seven books, a comedian, and two actors with the name "Rogan," and over 1,000 listings in a phone directory and almost 20,000 articles from a NEXIS database. In the instant case, there is one relatively minor (voice) actress and a small number of questionable and/or unreliable references to "Adlon" and no evidence showing U.S. consumers make a surname connection with this actress or any other perception of ADLON as a surname. *In re Gregory* does not support a refusal of registration of ADLON as primarily merely a surname.

Additionally, the Examining Attorney's Brief cites to several cases regarding the unregistrability of a surname even when it is "relatively rare." EA Brief, p. 5-7. However, these cases are distinguishable from the facts at hand: *In re Etablissements Darty et Fils.*, 759 F.2d 15, 17 (Fed. Cir. 1985) (affirming DARTY primarily merely a surname in part because the current principal of the business was named "Darty" and the name of the company indicated this was his

last name because “Darty et Fils” means Darty and Son and, thus, the public “would perceive DARTY as a surname”); *In re Adrian Giger and Thomas Giger*, 78 USPQ2d 1405 (TTAB 2006) (finding GRIGOR to be primarily merely a surname because both joint applicants’ surnames were Grigor and they advertised such in their promotional materials); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988) (finding the examining attorney had established a *prima facie* case that the primary significance of the mark was that of a surname and affirming refusal of PIRELLI despite scant evidence of surname usage because principal of applicant was named Pirelli and Pirelli looked like a surname); and *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986) (affirming refusal of registration of PETRIN based on *prima facie* evidence of surname use when Applicant did not submit evidence to rebut, but only attempted argument was that PETRIN was an abbreviated contraction of “petroleum” and “insulation”). It is important to note that many of these cases were decided well before “*Baik*” and the progress of the internet in searching national databases. Accordingly, under today’s standard, the scarce and unreliable evidence of record in the instant case is even more persuasive that ADLON is, at best, an extremely rare surname and should be allowed registration on the Principal Register.

The Examining Attorney also relies on another case that was decided before the prevalent use of the internet and thus what might seem like fewer listings must be considered in context, particularly where other factors might be present that are inapplicable in the current case. *See In re Cazes*, 21 USPQ2d 1796 (TTAB 1991) (affirming refusal of registration of BRASSERIE LIPP based on *prima facie* evidence of surname use). *Cazes* was decided in 1991, well before “*Baik*,” and other cases since then have indicated the Board recognizes that, especially in light of the readiness of information from the internet, the rareness of a surname should be an important factor in the determination of whether a mark is primarily merely a surname. *See In re Peter*

Schottler GmbH, *3 2012 WL 5196148 (TTAB) (reversing examining attorney’s refusal of registration because, *inter alia*, there were only 40 listings of record and despite the fact that the firm was founded in 1840 by a man named SCHOTTLER, finding “this factor does not weigh heavily in our analysis”) [non-precedential].¹ Likewise, in this case, because there is no one associated with Applicant by the name “Adlon,” and no evidence that any association would be made unlike LIPP in *Cazes*, and the scarcity of the listings of “Adlon” as a surname, it is clear that the mark ADLON is not primarily merely a surname and should be allowed registration on the Principal Register. This all must be considering with the backdrop of doubt being resolved in Applicant’s favor and where this is no evidence showing consumer perception as a surname associated with Applicant, no association should be presumed and this applies for all the relevant factors.

¹ We include a copy of the opinion for the Board’s convenience at Exhibit A.

III. SUMMARY

Applicant respectfully requests the Board reverse the refusal under Section 2(e)(4), and allow Applicant's mark, ADLON, to register on the Principal Register. The ADLON mark is, at best, an extremely rare surname and the mark is perceived by the consumer as a trademark and a source indicator and is thus not primarily merely a surname. Additionally, the sparse evidence of record does not establish the mark is primarily merely a surname, and thus there is no reliable evidence showing that ADLON is perceived by the relevant public as a surname. Accordingly, Applicant's mark should be published for opposition.

Respectfully submitted,

Adlon Brand GmbH & Co. KG c/o FUNDUS
FONDS – Verwaltungen GmbH

Dated: January 5, 2015

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EXHIBIT A

2012 WL 5196148 (Trademark Tr. & App. Bd.)

THIS DECISION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE PETER SCHÖTTLER GMBH

Serial No. 79092036

September 28, 2012

Filed February 3, 2011

*1 [Mark P. Stone](#), Esq.; [Amanda L. Stone](#), Esq. on the brief, for applicant

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Managing Attorney

Before [Mermelstein](#), [Wellington](#), and [Wolfson](#)

Administrative Trademark Judges

Opinion by [Mermelstein](#)

Administrative Trademark Judge:

Applicant requests extension of protection for the mark SCHÖTTLER (in standard characters) to be used on or in connection with a variety of metal products, metalworking and forging services, and engineering services in International Classes 6, 40, and 42.¹ The examining attorney issued a final refusal to register, alleging that the mark is primarily merely a surname. Trademark Act § 2(e)(4); [15 U.S.C. § 1052\(e\)\(4\)](#).

We will reverse the refusal to register.

I. Applicable Law

Section 2(e)(4) of the Trademark Act prohibits registration on the Principal Register if the proposed mark is “primarily merely a surname.” The determination of whether the primary significance of the designation at issue is that of a surname is based on the facts made of record. [In re Etablissements Darty et Fils](#), 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). The Examining Attorney has the initial burden to make a *prima facie* showing of surname significance. *Id.* If the Examining Attorney makes that showing, then we must weigh all of the evidence from the examining attorney and the applicant to determine ultimately whether the mark is primarily merely a surname. [In re Sava Research Corp.](#), 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we must resolve that doubt in favor of applicant. [In re Benthin Management GmbH](#), 37 USPQ2d 1332, 1334 (TTAB 1995).

In *Benthin*, we identified five factors -- four of which are relevant here -- to consider in determining whether a mark is primarily merely a surname:

1. The degree of the surname's “rarity”;
2. Whether anyone connected with the applicant has the involved term as a surname;
3. Whether the mark has any recognized meaning other than as a surname; and,

4. Whether the mark has the “look and sound” of a surname.

*2 *Id.* at 1333. Because the mark at issue here is in standard character form, we need not consider the fifth *Benthin* factor, *i.e.*, whether the manner in which the mark is displayed might negate any surname significance.

II. Discussion

A. The Rareness of SCHÖTTLER

With her first Office action, the examining attorney made of record results of a search on the website www.whitepages.com. The results pages list -- under the words “Over 100 Results,” a number of people with the name Schottler,² as well as some vague information about each, including a range for the listee's age, and a street and city (presumably of the person's residence). According to the examining attorney, [t]his evidence shows the applied-for mark appearing at least 100 times as a surname in a nationwide telephone directory of names (the first 50 listings are attached). Given the amount of evidence showing mark [*sic*] used as a surname, consumers would immediately perceive that the term Schöttler as used in the mark is also used as a surname.

First Office action (Feb. 9, 2011).

In fact, this evidence shows only *forty* listings, and as applicant points out, several of the listings appear to be duplicates: there are two listings each for Ann M. Schottler in Kentucky, Doreen Schottler in New Jersey, and Frederick Schottler in White Plains, NY. In response to the listing, and again in its brief, applicant argued that the number of Schottlers listed in the examining attorney's evidence is insufficient to show that SCHÖTTLER is primarily merely a surname.³

While the examining attorney is correct that there is no minimum number of listings required to show surname significance, *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991), it is not the case that any number of listings will do, no matter how small. The issue is whether the surname in question is common or rare, and in each case, the rareness of the surname must be considered as a part of all the record evidence pertaining to the *Benthin* factors. Nonetheless, it is fair to say that the rareness of the name at issue often plays an important role in determining whether the proposed mark is primarily merely a surname. *E.g.*, *In re Joint-Stock Co. “Baik”*, 84 USPQ2d 1921, 1923-24 (TTAB 2007).

In this case, although the examining attorney states that individuals named Schottler appeared “at least 100 times” in the results of her [whitepages.com](http://www.whitepages.com) search, only forty listings were submitted, even after applicant argued that the listings were too few to support the § 2(e)(4) refusal. (The estimate of “at least 100” listings appears to be based on the [whitepages.com](http://www.whitepages.com) notation of “Over 100 Results,” but we cannot tell whether that vague figure is reliable or how many listings there actually were -- and one hundred listings is still a very small number resulting from a national search.⁴) We cannot affirm a refusal to register based on evidence which is not of record, particularly in light of the small number of listings actually submitted and the fact that applicant has questioned the sufficiency of those listings.

*3 We find that the forty⁵ listings of record put SCHÖTTLER in the category of very rare surnames, particularly in the absence of any other evidence showing that the public would recognize it as a surname notwithstanding its rareness.⁶ See *e.g.*, *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004) (only 1100 directory listings, but evidence of “publicity accorded to public personalities with the name”).

This factor weighs strongly in applicant's favor.

B. Applicant's Connection with SCHÖTTLER

Applicant admits that its firm was founded in 1840 by a man named Peter Schöttler, but states that there is nobody named Schöttler currently associated with the firm. App. Br. at 4. The mere fact that applicant's founder is long gone is not necessarily a factor in applicant's favor, but there is no indication in this case that Mr. Schöttler was a famous figure (or still is), or that the U.S. public is even aware of him or the history of the firm. Nor does it appear that those dealing with the firm would come into contact with anyone named Schöttler.

Of course, applicant's corporate name is Peter Schöttler GmbH, and it seems likely that in that context -- preceded by the given name Peter -- that the relevant public would be somewhat more likely to view Schöttler as a surname, but there is no evidence that applicant currently does any business in or with the United States,⁷ or that the firm is otherwise known in this country. In any event, we must base our determination on the applied-for mark, which is SCHÖTTLER, not Peter Schöttler.

While applicant's firm was founded by someone named SCHÖTTLER, we find that under the circumstances of this case, this factor does not weigh heavily in our analysis.

C. Other Recognized Meanings

The examining attorney submitted two searches of online dictionaries (one English, one German) for the term "Schöttler." Final Office Action (July 1, 2011). Inasmuch as neither search found a definition for Schöttler, the examining attorney argues that the term has no recognized meaning other than that of a surname. Applicant does not contend that Schöttler has some significance other than as a surname, but argues that this evidence is somehow "duplicative." Reply Br. at 3-4. We are puzzled by applicant's argument -- this evidence is clearly probative of the third *Benthin* factor, and we agree with the examining attorney that this factor weighs in favor of affirmance.

D. Whether SCHÖTTLER has the Look and Sound of a Surname

The examining attorney argues that SCHÖTTLER has the look and sound of a surname:

The examining attorney submits that there are a number of surnames used in the United States that begin with the letters "Sch." In addition, many surnames used and heard in the United States contain accent marks. Given that many surnames used in the United States contain similar letter sequences as the proposed mark, and also contain accents, the American public would in fact perceive SCHÖTTLER as a surname.

*4 Ex. Att. Br. at 10 (unnumbered).

This *Benthin* factor is somewhat subjective. *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009). However, even subjective determinations must be based on some evidence. As applicant points out, the examining attorney has submitted no evidence in support of her argument about common surnames in the United States. See e.g., *Baik*, 84 USPQ2d 1921, 1924 (TTAB 2007) (evidence from Yahoo People Search "to show that 'more common' surnames ... are similar in appearance and sound"); *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285 (TTAB 2007) ("examining attorney's evidence from about.com shows that ... many surnames end with 'son'"); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988) (PIRELLI, though rare, resembles common surnames in the *American Surnames* book).

While we agree that SCHÖTTLER could *possibly* be perceived as a surname, that conclusion is not inevitable. Applicant argues that "the American consumer is fairly unfamiliar with words and names containing the letters 'SCH' and 'Ö', which are uncommon in the English language. Accordingly, the American consumer is unlikely to recognize the mark 'SCHÖTTLER' at all, let alone as a surname." App. Br. at 11. We conclude that in the absence of evidence to support it, we are not able to give the examining attorney's unsupported opinion on this factor any weight. We conclude that this factor is essentially neutral.

III. Conclusion

In summary, we have found that SCHÖTTLER is a very rare surname and that applicant's founder was named Peter Schöttler, although in this case, that latter factor is not entitled to substantial weight. And while SCHÖTTLER has no other apparent meaning, we are unable to conclude on this record that the mark has the “look and sound” of a surname.

On balance, we find the degree of rareness of the surname SCHÖTTLER to be a factor which weighs heavily in favor of reversal,⁸ outweighing the fact that the mark has no other meaning and that applicant's founder was named Schöttler. On this record, we conclude that the Office has not met its burden to show that the mark is primarily merely a surname.

Decision: The refusal to register on the ground that the mark is primarily merely a surname is reversed.

Footnotes

- 1 Pursuant to Trademark Act § 66(a); 15 U.S.C. § 1114f(a), and alleging a *bona fide* intent to use the mark in commerce. Applicant is the holder of International Registration No. 1063656, issued September 20, 2010, claiming a priority date of March 25, 2010.
- 2 Applicant points out that the examining attorney's evidence shows individuals with the last name “Schottler” and not “Schöttler,” as in the applied-for mark. While we recognize the difference made by the umlaut in the spelling and German pronunciation of the name, it is unclear whether the relevant U.S. consumers would see this spelling variation as significant. We will assume, without deciding, that if Schottler is primarily merely a surname, so is SCHÖTTLER; our decision would be the same in either case.
- 3 Applicant argues that “[t]ypically, an Examiner is required to demonstrate an ‘unusually large number’ of telephone directory listings of the mark as a surname to carry the burden of proof.” App. Br. at 4 (citing *In re Harris-Intertype, Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975)). Applicant is plainly incorrect. The court in *Harris-Intertype* found that the “unusually large number of listings” of record in that case was *sufficient* to establish that the applied-for mark was primarily merely a surname; the court did not say that an “unusually large number of listings” was *necessary* to sustain such a refusal in all cases. *Harris-Intertype*, 186 USPQ at 239.
- 4 Some of our cases have affirmed refusals with evidence of only a very small number of listings. It should be kept in mind that in many of the older cases, the listings typically came from (paper) telephone directories for a few cities. While those cases are still good law, it seems clear that unless the name is extremely rare, the search of a national database will likely turn up more listings than the search of the phone books of a few cities. See *In re United Distillers plc*, 56 USPQ2d 1220, 1221 (TTAB 2000).
- 5 While the submission of cumulative evidence is discouraged, the value of this evidence lies not in the listed names, but in their *number*. Although every single listing need not be submitted, it remains the examining attorney's burden to demonstrate that the evidence supports the refusal of registration, and submission of a very small number of listings may prove inadequate to demonstrate that the name at issue is not rare.
- 6 Although the examining attorney submitted a profile from the Xing website of a person named Jan Schöttler, a graphic designer and art director, this Mr. Schöttler apparently resides in Munich, Germany, and there is no evidence that he is well-known (or known at all) in the United States.
- 7 As noted, applicant seeks registration under Trademark Act § 66(a). Such applicants need not show use in U.S. commerce prior to registration. *Id.*
- 8 In addition to our earlier discussion, we note Judge Seeherman's observation that “[i]f a surname is extremely rare, it is also extremely unlikely that someone other than the applicant will want to use the surname for the same or related goods or services as that of the applicant.” *Baik*, 84 USPQ2d at 1924 (Judge Seeherman, concurring).

2012 WL 5196148 (Trademark Tr. & App. Bd.)